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EXAMINER

DIVECHA, KAMAL B

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,337

Applicant(s)

SIMPSON ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Claims 1-23 are pending in this application.

Claim Objections

The claim objections made in the prior final office action have been withdrawn.

Claim Rejections - 35 USC § 112

Applicant's amendment presents the new matter and therefore necessitated the new matter rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the limitation of "selecting an imaging conversion program **from a plurality of imaging conversion programs based on a criterion**". However, the specification merely describes a method, system and program product for providing imaging conversion services on content comprising the step of selecting an imaging conversion program based on a criteria (see Abstract, pg. 2-5 para. [0003-0022]). There is no whatsoever any indication and/or teaching of the process of selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion in the disclosure, hence, the above claimed limitation

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presents new subject matter situations and was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's arguments filed July 25, 2005 have been fully considered, as per request for continued examination (RCE) filed on September 23, 2005, but they are not persuasive.

The examiner summarizes the applicant's arguments presented in the response filed on July 25, 2005 and addresses each argument individually.

As per applicant's arguments filed on July 25, 2005, the applicant argues in substance that:

- a. "Li does not disclose or suggest selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion (remarks, page 7). Li discloses a system, illustrated in Li, fig. 3, that includes only a single transformation service whose services are invoked by the intermediary when an incoming request requests transformation. Li makes no mention or suggestion of any additional transformation services let alone making a selection from among additional transformation services".

In response to applicant's argument as in (a), examiner strongly disagrees in light of the following teachings by Li:

Li discloses a system (i.e. an apparatus and/or server) comprising a plurality of transformation templates (i.e. imaging conversion program, fig. 3 item #330 and page 2 [0022] and [0016]) that performs the content transformation.

Applicant seems to argue based on fig. 3 of Li that discloses a single server and argues that Li does not disclose plurality of transformation services, however fig. 3 of Li is an apparatus comprising one or more transformation computer programs or templates that performs the content conversions (page 2 [0022], [0016], page 4 [0041]).

Li explicitly discloses the process of selecting an imaging conversion program (i.e. a template that would convert the content from one format to another) from a plurality of imaging conversion programs based on criterion (pg. 2 [0016], [0018], [0022], pg. 3 [0033], [0038], pg. 4 [0040]-[0041], pg. 5 [0049]). The cited paragraphs of Li clearly indicate that the template (i.e. an imaging conversion program) that would perform transformation of content is selected from one or more templates (i.e. plurality of templates) based on the selection criteria.

b. “Claim 19 is directed to a system for implementing the method of claim 1. For the same reasons claim 1 is patentable, so are claim 19 and claim 22 which depends from claim 19 (remarks, page 7)”.

In response to applicant’s argument as in (b): Li discloses each and every limitation of the base claim 1 as set forth above and in the detailed action and therefore claim 19 and 22 are rejected for the same reasons as set forth in claim 1.

c. “Claim 20 is directed to a computer readable medium containing code for implementing the method of claim 1. For the same reasons claim 1 is patentable, so are claim 20 and claim 23 which depends from claim 20 (remarks, page 7)”.

In response to applicant’s argument as in (c): Li discloses each and every limitation of the base claim 1 as set forth above and in the detailed action and therefore claim 20 and 23 is rejected for the same reasons as set forth in claim 1.

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d. “Claim 5 and claim 13-16 depends from claim 1 and includes all the limitations of that base claim. For at least the same reasons claim 1 is patentable, so is claim 5 and 13-16 (remarks, page 7-8)”.

In response to applicant’s argument as in (d): Li discloses each and every limitation of the base claim 1 as set forth above and in the detailed action and therefore claim 5 and 13-16 are rejected for the same reasons as set forth in claim 1 and further in view of Todaka (USPN 6,785,022) and in view of Houser (see the action below).

For at least the reasons set forth above and in the detailed action, the Examiner submits that the pending claims are not in condition for allowance.

The art rejection is maintained.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation “the web service” in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation “the web service web site” in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12, and 17-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Li (Pub. No.: US 2004/0205613).

As per claim 1, Li discloses a method for providing imaging conversion services on content, comprising the steps of:

receiving content comprising non-image data (par. 41, lines 2-4);

obtaining a style sheet defining a conversion of the received content to a converted content (par. 41, lines 4-7; par. 22, line 1);

selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion (par. 52, lines 24-27; pg. 2 [0016], [0018], [0022], pg. 3 [0033], [0038], pg. 4 [0040]-[0041], pg. 5 [0049]);

converting the content using the selected imaging conversion program and the style sheet to obtain the converted content (par. 41, lines 10-11); and

transmitting the converted content to a desired location (par. 42, lines 1-3).

As per claim 2, Li discloses that the web service is at a web site identified by a URL reference (par. 54, lines 1-4).

As per claim 3, Li discloses that the content is obtained from a source web site that is different from the web service web site (par. 18, lines 3-4); and wherein the obtaining a style sheet step comprises receiving a style sheet from the source web site (par. 18, lines 3-6).

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As per claim 4, Li discloses that the content is obtained from a source web site that is different from the web service web site (par. 18, lines 3-4); and wherein the obtaining a style sheet step comprises selecting a default style sheet (par. 41, lines 5-6).

As per claim 6, Li discloses that the criterion for the selecting a conversion program step selects a conversion program dynamically based on a negotiation taking place between the web service and a requestor and based on capabilities of each (par. 52, lines 24-27; par. 15, lines 1-3; and par. 16, lines 3-4).

As per claim 7, Li discloses that the transmitting step comprises the step of transmitting the converted content to a consuming web site or service (par. 45, lines 19-21).

As per claim 8, Li discloses that the transmitting step comprises transmitting the converted content to storage in a personal imaging repository (par. 42, lines 1-3).

As per claim 9, Li discloses that the transmitting step comprises transmitting a reference to the converted content, with the reference referring to the converted content (par. 41, lines 12-13).

As per claim 10, Li discloses that the selecting an imaging conversion step comprises associating a reference for the selected imaging conversion program to the content or to a reference for the content and making that content or the content reference accessible to a user, to thereby permit the converting step to be performed on a demand basis (par. 18, lines 3-6; par. 16, lines 3-4; and par. 24, lines 3-5).

As per claim 11, Li discloses that the receiving content step comprises receiving a reference to the content and associating the content reference to a reference for the web service method and making this content reference accessible to a user, so that the conversion services may be performed on a demand basis (par. 18, lines 3-6; par. 16, lines 3-4; and par. 24, lines 3-5).

As per claim 12, Li discloses that the converted content is stored on the web service (par. 52, lines 34-37).

As per claim 17, Li discloses that said obtaining a style sheet step comprises allowing a user to configure a style sheet for use with the method (par. 24, lines 6-7).

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As per claim 18, Li discloses that the transmitting step comprises transmitting the content to another service (par. 45, lines 19-21).

As per claim 19, Li discloses a system for providing imaging conversion services on content, comprising:

- a component for receiving content comprising non-image data (par. 41, lines 2-4);
- a component for obtaining a style sheet defining a conversion of the received content to a converted content (par. 41, lines 4-7; par. 22, line 1);
- a component for selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion (par. 52, lines 24-27);
- a component for converting the content using the selected imaging conversion program and the style sheet to obtain converted content (par. 41, lines 10-11); and
- a component for transmitting the converted content to a desired location (par. 42, lines 1-3). As per

As per claim 20, Li discloses a program product on a computer readable medium for implementing a method when executed on a computing system, the program product comprising:

- code for providing imaging conversion services on content (par. 52, lines 24-27); code
- for receiving content comprising non-image data (par. 41, lines 2-4);
- code for obtaining a style sheet defining a conversion of the received content to a converted content (par. 41, lines 4-7; par. 22, line 1);
- code for selecting an imaging conversion program from a plurality of imaging conversion programs based on a criteria (par. 52, lines 24-27);
- code for converting the received content using the selected imaging conversion program and the style sheet to obtain the converted content (par. 41, lines 10-11); and
- code for transmitting the converted content to a desired location (par. 42, lines 1-3).

As per claim 21, Li discloses that the converted content comprises an image (par. 34, line 3).

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As per claim 22, Li discloses that the converted content comprises an image (par. 34, line 3):

As per claim 23, Li discloses that the converted content comprises an image (par. 34, line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li (Pub. No.: US 2004/0205613) in view of Todaka (U. S. Patent No. 6,785,022).

As per claim 5, Li does not expressly disclose that the criteria for the selecting a conversion program step comprises selecting a conversion program based on a parameter of a printer to be used to print the content.

Todaka teaches that it is known to convert a document to make it compatible with a printer (col. 4, lines 25-26).

Li and Todaka are analogous art because they are both from the same field of endeavor of computer networks.

At the time of invention, it would have been obvious to one of ordinary skill in the art that Li's invention could be used to convert documents in order to make them compatible with a printer, as taught by Todaka. The motivation for doing so would have been to use Li's system as a way to consistently convert documents according to a template that makes them compatible with the printer.

Therefore it would have been obvious to combine Todaka with Li for the benefit of conversion with a template to obtain the invention as specified in claim 5.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (Pub. No.: US 2004/0205613) in view of Houser ("Using Style Sheets to Publish XML to the Web").

As per claim 13, Li does not disclose the process of filtering the content to delete selected items therein.

Houser, from the same field of endeavor, explicitly discloses the process of filtering the content to delete the selected content by using style sheets (pg. 4 L31).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to filter the content to delete selected items.

One of ordinary skilled in the art would have been motivated because these capabilities would have provided a powerful mechanism, not only for customizing the publishing of documents, but for transforming documents that can be displayed by any web browser (Houser, pg. 4).

As per claim 14, Li does not disclose the process of labeling different items in the content. Houser discloses the process of labeling different items in the content (pg. 4 L30). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to label different items in the content. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 13 above.

As per claim 15, Li does not disclose the process of reordering labeled content. Houser explicitly discloses the process of reordering labeled content (pg. 4 L35). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to reorder labeled content. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 13 above.

As per claim 16, Li does not disclose the process of changing a layout of the content on a page. Houser explicitly discloses the process of changing a layout of the content on a page (pg. 4 L35). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to change a layout of the content on a

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page. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 13 above.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- e. Yach, Pub. No.: US 2002/0112078 A1.
- f. Akimoto, U. S. Patent No. 6,775,711 B1.
- g. Kirkeby, U. S. Patent No. 6,721,803 B1.
- h. Camut et al., U. S. Patent No. 6,684,257 B1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 2151
12/29/05.



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